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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/553,666	08/01/2006	Brian John Higgins	4623-053150	3792
28289	7590	03/05/2009	EXAMINER	
THE WEBB LAW FIRM, P.C. 700 KOPPERS BUILDING 436 SEVENTH AVENUE PITTSBURGH, PA 15219			SMITH, NKEISHA	
			ART UNIT	PAPER NUMBER
			3632	
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			03/05/2009	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/553,666	<b>Applicant(s)</b> HIGGINS, BRIAN JOHN	
	<b>Examiner</b> NKEISHA J. SMITH	<b>Art Unit</b> 3632	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 7-9 and 11-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-9 and 11-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 October 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. The following correspondence is a non-final Office Action for application no. 11/533,666 for a GUTTER AND MOUNTING DEVICE FOR BUILDINGS, filed on 10/17/2005. This correspondence is in response to applicant's reply filed on 12/12/2008. Claims 7-9 and 11-26 are pending.

#### ***Priority***

2. Applicant is advised of possible benefits under 35 U.S.C. 119(a)-(d), wherein an application for patent filed in the United States may be entitled to the benefit of the filing date of a prior application filed in a foreign country.

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

#### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 7-13, 22, 25 and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Regarding claim 7, there is an inconsistency between the language in the preamble of claim 7 and certain portions in the body of the depending claims, thereby making the scope of the claims unclear. The preamble in claim 7 clearly indicates that a subcombination is being claimed, e.g., "a mounting device... which is attachable to the building and a gutter mounting section...." This language would lead the examiner to believe that the applicant intends to claim

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only the subcombination of "a mounting device," the gutter mounting section being only functionally recited. This presents no problem as long as the body of the claims also refer to the functionally, such as, "for attachment to said gutter mounting section."

The problem arises when the gutter mounting section is positively recited within the body of the claim, which states, "the gutter mounting section including a plurality of gutter retaining clips." There is an inconsistency within the claims; the preamble of claim 7 indicates subcombination, while in at least one instance there is a positive recital of structure indicating that the combination of a mounting device and a gutter mounting section are being claimed. The examiner cannot be sure if applicant's intent is to claim merely the mounting device or the mounting device in combination with the gutter mounting section. Applicant is required to clarify what the claims are intended to be drawn to, i.e., either the mounting device alone or the combination of the mounting device and the gutter mounting section. Applicant should make the language of the claims consistent with applicant's intent. In formulating a rejection on the merits, the examiner is considering that the claims are drawn to the combination and the claims will be rejected accordingly. If applicant indicates by amendment that the combination claim is the intention, the language in the preamble should be made consistent with the language in the body of the claims. If the intent is to claim the subcombination, then the body of the claims must be amended to remove positive recitation of the combination.

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7. Claim 9 recites the limitation "the inner wall" in line 3. There is insufficient antecedent basis for this limitation in the claims.

8. Claims 13, 22, 25 and 26 recite the limitation regarding "a fall angle." This term is undefined and unclear. Appropriate clarification is requested.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 7-9, 11-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Lasscock (3,864,882).

Regarding claim 7, as best understood, Lasscock teaches a mounting device (Figs. 1, 2), the mounting device including an elongated device body (20) which includes an attachment section (29) which is attachable to the building and a gutter mounting section (21), the gutter mounting section including a plurality of gutter retaining clips (22) spaced apart from one another in the longitudinal direction.

Regarding claim 8, as best understood, Lasscock teaches the device of claim 7, wherein said elongated device body includes a generally U-shaped portion, one leg thereof being the attachment section and the other leg thereof being the gutter mounting section, the legs of the U- shaped portion being spaced apart.

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Regarding claim 9, as best understood, Lasscock teaches the device of claim 8, wherein the gutter retaining clips include projections which extend into the recess.

Regarding claim 11, as best understood, Lasscock teaches the device of claim 9, wherein said projections are hook-like elements. The examiner notes that this claim involves improper method limitations, because the claim is directed to an apparatus, which are not given any patentable weight.

Regarding claim 12, as best understood, Lasscock teaches the device of claim 8, further including a plurality of access apertures (holes located in gutter mounting section through which elements 22 are connected) in the gutter mounting section.

Regarding claim 13, as best understood, Lasscock teaches the device of claim 7, wherein the retaining clips are aligned at an angle with respect to a single edge of the mounting device.

Although claim 14 recites purely functional limitations, as best understood, Lasscock teaches the device of claim 7, wherein the attachment section is capable of receiving fasteners.

Regarding claim 15, as best understood, Lasscock teaches the device of claim 8, wherein the body is channel shaped and is generally U-shaped in cross-section transverse to the longitudinal direction.

Regarding claim 16, Lasscock teaches a gutter and mounting device (Figs. 1, 2), the gutter (35) comprising a generally channel or trough shaped body with an inner wall having a gutter mounting thereon, the mounting device

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including an elongated device body (20) that extends in a longitudinal direction between opposite ends, the body including an attachment section (29) which is attachable to the building and a gutter mounting section (21), the gutter mounting section including a plurality of gutter retaining clips (22) spaced apart from one another in the longitudinal direction.

Regarding claim 17, Lasscock teaches the device of claim 16, wherein said elongated body includes a generally U-shaped portion, one leg thereof being the attachment section and the other leg thereof being the gutter mounting section, the legs of the U-shaped portion being spaced apart.

Regarding claim 18, Lasscock teaches the device of claim 17, wherein the gutter retaining clips include projections which extend into the recess and are adapted to cooperate with the gutter mounting on the inner wall of the gutter.

Regarding claim 19, Lasscock teaches the device of claim 18, wherein the gutter mounting on the inner wall of the gutter is a raised elongated rib which, when the gutter is in the installed position, is disposed within the recess and inhibited from removal by said projections (Fig. 2).

Regarding claim 20, Lasscock teaches the device of claim 18, wherein said projections are hook-like elements pressed or punched out of the gutter mounting section. The examiner notes that this claim involves improper method limitations, because the claim is directed to an apparatus, which are not given any patentable weight.

Regarding claim 21, Lasscock teaches the device of claim 18, further including a plurality of access apertures in the gutter mounting section.

Regarding claim 22, as best understood, Lasscock teaches the device of claim 16, wherein the retaining clips are aligned at an angle with respect to a single edge of the mounting device corresponding to a fall angle required when the gutter is in the installed position.

Although claim 23 recites purely functional limitations, as best understood, Lasscock teaches the device of claim 16, wherein the attachment section is capable of receiving fasteners.

Regarding claim 24, as best understood, Lasscock teaches the device of claim 16, wherein the body is channel shaped and is generally U-shaped in cross-section transverse to the longitudinal direction.

Regarding claim 25, as best understood, Lasscock teaches a method of installing a gutter, comprising the steps of: attaching a mounting device to a building, the mounting device comprising an elongated device body and including a plurality of retaining clips, the mounting device being positioned on the building, and mounting the gutter to the device by moving the gutter to the installed position where the retaining clips cooperate with the gutter to retain the gutter in the installed position.

Regarding claim 26, as best understood, Lasscock teaches the method of claim 25, wherein the retaining clips of the mounting device are aligned at an angle with respect to a single edge of the mounting device corresponding to the fall angle, and the step of attaching the mounting device to the building further comprises aligning the single edge of the mounting device to an edge of the building.



***Response to Arguments***

11. Applicant's arguments filed 12/12/2008 have been fully considered but they are not persuasive.

Applicant states that the prior art reference does not teach "an elongated device body that extends in a longitudinal direction between opposite ends, the body including... a gutter mounting section including a plurality of gutter retaining clips spaced apart from one another in the longitudinal direction." The Examiner respectfully disagrees. As indicated above, and as shown in Fig. 2 of the prior art reference, the prior art does in fact teach an elongated device body (20) that extends in a longitudinal direction between opposite ends, the body including an attachment section (29) and a gutter mounting section (21), the gutter mounting section including a plurality of gutter retaining clips (22) spaced apart from one another in the longitudinal direction. Further, as shown in Fig. 2, the clips (22) are spaced apart from one another in the longitudinal direction, as in a lengthwise direction.

***Conclusion***

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory

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action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NKEISHA J. SMITH whose telephone number is (571)272-5781. The examiner can normally be reached on Monday - Friday, 7:30 a.m. - 4:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. Allen Shriver can be reached on (571) 272-6698. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service

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Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/NKEISHA J. SMITH/  
Examiner, Art Unit 3632

March 2, 2009

/J. ALLEN SHRIVER II/  
Supervisory Patent Examiner, Art Unit 3632